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In re Application of : DECISION ON PETITION
COHEN :
Serial No.: 10/564,357 :
PCT No.: PCT/IL04/00584 : UNDER 37 CFR 1.47(b)
Int. Filing Date: 01 July 2004 :
Priority Date: 15 July 2003 :
Atty Docket No.: 26886U :
For: ROTARY SPRINKLER WITH REDUCED WEAR :

This decision is in response to the "Petition Under 37 CFR 1.47(b) For Filing When an Inventor Refuses to Sign" filed 12 January 2006.

BACKGROUND

On 01 July 2004, applicant filed international application PCT/IL04/00584 which claimed priority to a previous application filed 15 July 2003. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 27 January 2005. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States expired at midnight on 15 January 2006.

On 12 January 2006, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1); an Information Disclosure Statement; an assignment document for recording and the petition under 37 CFR 1.47(b) considered herein.

DISCUSSION

I. Transmittal Letter Filed 12 January 2006

Applicant is advised that the "Transmittal Letter to The United States Designated/Elected Office (DO/EO/US) Concerning a Filing Under 35 U.S.C. 371" filed 12 January 2006 identifies the international application number as PCT/IL2004/000548. It appears from the bibliographic information provided that applicant intends to file a U.S. National stage entry for international application PCT/IL2004/000584. In order for the present papers to be considered a U.S. National stage entry under 35 U.S.C. 371 applicant is advised to file a petition under 37 CFR 1.182 asking that the international application number be corrected.

II. Petition Under 37 CFR 1.47(b)

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the requisite petition fee under 37 CFR 1.17(g); (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the non-signing inventor; (4) an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as an agent for the non-signing inventor; (5) proof of proprietary interest in the application; and, (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages. Applicant has satisfied items (1); (3); (5) and (6).

Regarding item (1), applicant is advised that the current petition fee for proceeding pursuant to 37 CFR 1.47 is \$200.00. The additional \$70.00 required will be charged to deposit account number 14-0112 as authorized in the filed transmittal letter.

As to item (2), as stated in the Manual of Patent Examination Procedure (MPEP), Section 409.03(d) Proof of Unavailability or Refusal, "Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature." 409.03(d) also states that:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted. Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts.

Applicant has not provided a statement from attorney Pugatsch confirming that a complete set of application papers was sent to Mr. Cohen and detailing the telephone conversation of 06 June 2005 in which Mr. Cohen allegedly promised to execute the new declaration.

Regarding items (4) and (5), applicant has not shown proof of proprietary interest in the application. (See MPEP section 409.03(f)). Applicant's present petition references a document signed by Mr. Erez Zimhoni executed on behalf of the corporate assignee and on behalf of the non-signing inventor, Mr. Cohen, however, a review of the papers filed 12 January 2006 does not find said document. Applicant is reminded that a compliant oath or declaration

under 37 CFR 1.497 (a)-(b) is required.

In light of the above, it is not possible to grant applicant's petition at this time.

CONCLUSION

For the reasons stated above, applicant's petition under 37 CFR 1.47(b) is **DISMISSED**, without prejudice.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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